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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,328	03/01/2002	Jeffrey E. Devall	3177-69461	3042
23643	7590	10/17/2003		
BARNES & THORNBURG 11 SOUTH MERIDIAN INDIANAPOLIS, IN 46204			EXAMINER MICHALSKY, GERALD A	
			ART UNIT 3753	PAPER NUMBER 12

DATE MAILED: 10/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/087,328

Applicant(s)

DEVALL, JEFFREY E.

Examiner

Gerald A. Michalsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-21,23-26 and 28-34 is/are allowed.
- 6) ☒ Claim(s) 1-13,22 and 27 is/are rejected.
- 7) ☒ Claim(s) 14 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. The terminal disclaimer filed on 24 September 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent to issue on Serial No. 10/079,163 has been reviewed and is accepted. The terminal disclaimer has been recorded.

2. The paper filed on 24 September 2003 under 37 CFR 1.131 has been considered but is ineffective to overcome the DeCapua et al reference.

Where the reference U.S. patent or U.S. patent application publication claims the same patentable invention, an affidavit or declaration under 37 CFR 1.131 is inappropriate. See Section 715 of the Manual of Patent Examining Procedure.

"A 37 CFR 1.131 affidavit is ineffective to overcome a United States patent or patent application publication, not only where there is a verbatim correspondence between claims of the application and of the patent, but also where there is no patentable distinction between the respective claims." See Section 715.05 of the Manual of Patent Examining Procedure.

"A U.S. patent or U.S. patent application publication that anticipates the claimed subject matter cannot be disqualified as prior art under 35 U.S.C. 103(c) or 37 CFR 1.130 or 37 CFR 1.131." See Section 718 of the Manual of Patent Examining Procedure.

The paper filed 24 September 2003 under 37 CFR 1.131 is also an improper declaration. The paper filed 24 September 2003 under 37 CFR 1.131 is signed by counsel for the applicant. A declaration filed under 37 CFR 1.131 must be signed by

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the inventor. See Section 715.04 of the M.P.E.P. The paper filed 24 September under 37 CFR 1.131 is also not a proper "declaration" because it does not include the statement beginning "I hereby declare that all statements herein of my own knowledge are true..." and which cites Section 1001 of Title 18 of the United States Code. The evidence of conception is insufficient and there is no proof of due diligence from conception to filing of the application. For all these reasons the paper filed 24 September 2003 under 37 CFR 1.131 is improper.

3. Claims 1-13, 22, and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by DeCapua et al. (U.S. Patent Application Pub. No. 2002/0112757). DeCapua et al. and this application have different inventive entities. DeCapua et al. is entitled to benefit of the filing date of February 16, 2001, which is the filing date of the provisional application for which priority is claimed. Therefore, the effective filing date of DeCapua et al. under 35 U.S.C. 102(e) is February 16, 2001. Claims 1-3, 7, and 12 are anticipated by Figures 10-14 of DeCapua et al. Claims 4-6, 8-11, 13, 22, and 27 are anticipated by Figure 14 of DeCapua et al.

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Claims 1-13, 22, and 27 herein are further provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 11-12, 16, and 18 of copending Application No. 10/079,163. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. Since claims 1-13, 22, and 27 herein are readable on the embodiments claimed in claims 11-12, 16, and 18 of Serial No. 10/079,163, and claims 11-12, 16, and 18 of Serial No. 10/079,163 are readable on the embodiments claimed herein, claims 1-13, 22, and 27 herein and claims 11-12, 16, and 18 of Serial No. 10/079,163 are in conflict and are drawn to the same invention. See Chart III-A of Section 804 of the M.P.E.P. with the route labeled "Commonly Assigned – Different Inventive Entities".

6. Claims 14-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claims 16-21, 23-26, and 28-34 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald A. Michalsky whose telephone number is (703) 308-1049. The examiner can normally be reached on M-F 5:30 AM - 2 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Scherbel, can be reached on (703) 308-1272. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0861.

A handwritten signature in black ink, appearing to read "Gerald A. Michalsky", written in a cursive style.

**Gerald A. Michalsky**  
**Primary Examiner**  
**Art Unit 3753**

GM  
October 16, 2003